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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,491	07/29/2003	Donald S. Hare	0175-0348P	5049

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EXAMINER	
SCHILLING, RICHARD L	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/628491	Hare et al
Examiner	**Group Art Unit**
R L Schilling	1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-16 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____ .

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____ .

Attachment(s)

☑ Information Disclosure Statement(s), PTO–1449, ~~Paper No(s).~~ 7-29-03

☐ Interview Summary, PTO–413

☑ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

1. Claims 1-16 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. The specification fails to contain a written description of the processes set forth in the instant claims wherein the last step of heating the non-stick sheet to drive the dry peel coating into the receptor element is not limited to heating by hand ironing. The specification incorporates the disclosure of provisional application 60/013,193, which discloses processes encompassed by the instant claims, by incorporation by reference. However, the provisional application does not disclose any heat press or generic heating for the last step of the instant claims of heating through the non-stick sheet. In the provisional application, heat press is disclosed in the discussion of known processes using hot peel without the step of peeling the image coating from its support prior to heating (by either heat presses or hand ironing) as required by the instant claims. The first paragraph of 35 U.S.C. § 112 requires a written description of the invention in clear terms. In the processes of the instant claims, the specification does not disclose the use of a heat press or generic heating in the last step. The instant application, like provisional application 60/013,193, only discloses the use of heat presses with hot peel processes and not processes of the instant claims requiring

peeling the image coating from its support, placing it on a receptor and then heating with overlying non-stick sheets. The specification discloses that hand ironing may be inadequate as a replacement for heat presses in the prior art processes of heating an image coating on a hot peelable support while laminated to a receptor and then hot peeling off the support. The processes of the instant claims, which require more steps than the disclosed prior art processes, is disclosed as allowing the use of hand irons without the problems hand ironing causes in the prior art hot peel processes. The processes of the instant claims are disclosed as being directed to hand ironing and not generic heating; and the specification does not generically disclose the interchangeability of hand ironing and heat presses.

As mentioned in applicants' arguments in parent application Serial No. 09/995,681, now U.S. Patent No. 6,638,682, page 14 of the specification discloses that processes preferably exclude pressures allowable with heat presses. However, this process being referred to on page 14 is not covered by the instant claims but rather is directed to another disclosed process requiring hot peel transfer as disclosed on page 14, line 31 - page 15, line 16 of the specification. The description of the process of the instant claims is disclosed as another

embodiment relating to cold peel on page 17, line 18 - page 19, line 10 of the specification. There is no disclosure in the specification regarding the embodiment covered by the instant claims that heat presses may be used instead of hand ironing even as a non-preferred heating source. The description in the specification covering the claimed processes is limited to hand ironing in the last step even though it may be obvious to one skilled in the art to substitute a heat press for hand ironing in view of what is known in the prior art. The last step of the claimed invention using overlying non-stick sheets is recited in the specification for the express purpose of allowing for hand ironing. The process disclosed on page 14 is directed to processes where the image transfer coating layer is first heat transferred by hand ironing, which results in incomplete transfer, followed by a second hand ironing to complete transfer and not processes as in the instant claims where the first heat pressing by hand ironing is excluded. The use of heat presses and cold stripping processes from supports as in the instant claims as compared to hand ironing heat pressing from supports is not disclosed on page 14. Page 14 addresses the problem of incomplete hand ironing transfer while the processes of the instant claims do not include hand iron transfer from a support but rather stripping off the support from the transfer layer.

Even though heat presses and hand irons are known in the art as argued by applicants in parent Application Serial No. 09/995,681, the specification must contain a written description of the claimed processes and not merely make the claimed processes obvious in view of what is known in the art to one skilled in the art.

2. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,638,682. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims fully encompass the subject matter of the claims of the U.S.

patent which has hand ironing as the last step particularly since the only disclosed heating step for the last step of the instant claims is hand ironing in the specification.

3. The prior art cited by applicants and cited in the parent applications has been considered. The instant claims are identical to claims examined in parent Application Serial No. 09/995,681 prior to the last amendment.

4. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

July 8, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP ~~1100~~ 1752